

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

I. Disposition of Claims

Claims 29-48 are pending in this application. Claims 29 and 40 are independent. The remaining claims depend, directly or indirectly, from claims 29 and 40. Claims 29 and 40 have been amended to more clearly recite the present invention. Per the Examiner's suggestion, these amendments were made remove a negative limitation. These amendments were *not* made in view of the prior art.

II. Rejection(s) under 35 U.S.C § 103

Claims 29-48 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,851,149 ("Xidos") in view of U.S. Patent No. 6,336,095 ("Rosen"), and further in view of U.S. Patent No. 6,422,941 ("Thorner").

Claims 29 and 40 have been amended in this reply to clarify the present invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

As previously stated, claims 29-48 were rejected as being obvious in view of the prior art. The MPEP §2141 clearly sets forth the basic considerations, which apply to obviousness rejections.

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

- (A) The claimed invention must be considered as a whole;
- (B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination.
- (C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- (D) Reasonable expectation of success is standard with which obviousness is determined.

The Claimed Invention

In considering the invention as a whole, the Applicant recites claim 29 as amended for the Examiner's convenience.

An interactive gaming and audiovisual transmission system comprising:

a central gaming computer means for processing gaming data; and

a receiver/decoder for receiving broadcast audiovisual data relating to a live-action broadcast event, and for receiving from the central gaming computer means gaming data relating to the live-action broadcast event, wherein the receiver/decoder is configured to allow a user to place a bet on an outcome of the live-action broadcast event and configured to allow the user to view the live-action broadcast event as a third-party;

the receiver/decoder including:

a subscription card reading device for interacting with a user's subscription card for providing user access to the live-action broadcast event;

a bank card reading device for interacting with a user's bank card to read data stored thereon; and

a modem device for communicating data read from the user's bank card to a communication server connected to a bank server holding the user's bank account for transferring in response to said data credit from the user's bank account to a gaming account at the central gaming computer means in order to permit gaming in relation to the live-action broadcast event.

The terms in bold are the structural elements of the interactive gaming and audiovisual system as recited in amended claim 29. Those elements include a central gaming means and a receiver/decoder. The receiver/decoder further includes a subscription card reading device, a bank card reading device, and a modem device.

Additionally, claim 29 recites the role for each of the structural elements of the interactive gaming system. In particular, the receiver/decoder "receives audiovisual data" and "receives gaming data". Both the audiovisual data and the gaming data relate to a "live-action broadcast event." Moreover, in the present invention, the receiver/decoder is configured to allow a user to place a bet on an outcome of the live-action broadcast event. Additionally, the receiver/decoder is configured to allow the user to view the live-action broadcast event as a third party.

Advantageously, the present invention provides a method and apparatus that enables a user to quickly open and credit a gaming account in the comfort of his or her own home, thereby avoiding other elaborate payment methods.

Prima Facie Case of Obviousness

To establish a case of *prima facie* obviousness, the applied references must be shown to teach or suggest all of the elements of the claimed invention, individually or in combination. The Applicant respectfully points to MPEP §2143.03, which states—

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

The Applied References

The applied references are Xidos, Rosen, and Thorner. First, Xidos teaches to a distributed gaming system. Specifically, Xidos teaches a gaming system accessed through a set-top box in a hotel.

Next, Rosen teaches a feedback system for computer video games and simulations. Specifically, the system provides real-time tactile feedback to enhance the user's experience. For example, in a car racing video game, the steering wheel may shake if the user steers the car in the game off the road. Finally, Thorner teaches a method for electronic commerce.

Applied References Do Not Teach All the Elements of the Claims

When considering the applied references, individually and in combination, Xidos, Rosen, and Thorner fail to teach or suggest the structural elements having the functional characteristics as recited in amended claim 29.

Receiver/Decoder

In one aspect, Xidos, Rosen, and Thorner fail to teach or suggest a

receiver/decoder as recited in claim 29, because the combination of the references does not teach a receiver/decoder that receives audiovisual data and gaming data relating to a live action broadcast event. Further, the references do not teach that the receiver/decoder is configured to allow a user to place a bet on an outcome of the live-action broadcast event, in addition to the receiver/decoder being configured to allow the user to view the live-action broadcast event as a third party.

Rosen is related to electronic commerce and is completely silent to receiver/decoder technology. Thorner is related primarily to computer video games and simulations and also is completely silent to receiver/decoder technology.

Xidos does teach a set-top box. However, the set-top box as taught by Xidos does *not* receive audiovisual data and gaming data related to a live action broadcast event. Further, the set-top box in Xidos is not configured to allow the user to view the live-action broadcast event as a third party. For example, Xidos teaches audiovisual data and gaming data relating to computer simulated card games (*e.g.*, draw-poker, 8-liner, keno, blackjack). Additionally, the games as taught by Xidos require first party participation. In other words, in Xidos, a user places a bet based on their first party participation of playing a computer simulated game.

To put a fine point on the issue, the present invention as recited in claim 29 differs in two ways. First, a computer simulated card game is not a live-action broadcast event, *e.g.*, in one or more embodiments, a horse race, dog race, *etc.* Secondly, the set-top box in Xidos allows the user to place bets as a first party (participatory) user, whereas the receiver/decoder in the present invention allows the user to place bets as a third-party (non-participatory) user. In other words, in the present invention, the user places a bet as

a third party user on a dog race, for example, however, the third party user clearly does not participate in the dog race. The third party user is simply a viewer.

Subscription Card Reading Device

In a second aspect, Xidos, Rosen, and Thorner fail to teach or suggest a receiver/decoder as recited in claim 29, because the combination of the references does not teach a receiver/decoder that uses a subscription card reading device. The subscription card reading device in claim 29 recites, “a subscription card reading device for interacting with a user’s subscription card for providing user access to the live-action broadcast event.” Xidos, Rosen, and Thorner are completely silent to a subscription card reading device as recited in claim 29. Xidos and Thorner do not even mention the word “subscribe” or “subscription.” The credit card swipe device disclosed in Xidos is for making payments to place bets when playing the computer simulated card games. It is *not* used to provide access to the computer simulated. In Xidos, a user gain access to the computer simulated games by using the remote control and selecting the channel where the games are being featured. (Moreover, the present invention requires both a bank card reading device and a subscription card reading device, which are functionally different.) As for Rosen, Rosen only discusses subscription as it relates to communication between customer trusted agent and merchant trusted agent in an electronic commerce transaction. Rosen does not teach a subscription card device in receiver/decoder.

Deficiencies in the Combination

Referring to the four-prong test cited above in §2141 of the MPEP, the references

must suggest the desirability and thus the obviousness of making the combination. Further, the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention. Further, a reasonable expectation of success is standard must be determined.

The Applicant submits that there is no desirability or motivation to combine the references and, secondly, that the combination of the references was constructed in hindsight afforded by the claimed invention. Finally, there is no expectation of success when combining the references.

Motivation to Combine and Expectation of Success

First, there is no motivation to combine of Xidos and Thorner. The video games taught in Xidos are computer simulated card games. One of ordinary skill in the art would not be motivated to provide real-time tactile feedback to enhance a user's experience while interacting with a computer simulated card games, because actual card games do not have any real-time tactile output. Thorner teaches providing tactile feedback in computer/video games and simulations, for example, a simulated car racing game, where a user would expect tactile feedback from, say, a crash or steering off the road. Because there is no expectation of tactile feedback in a simulated card game, there is no motivation to combine Thorner with Xidos. Additionally, there is no motivation to combine Thorner and Rosen as their respective teachings, tactile feedback in computer/video games and electronic commerce communication, are vastly different.

Further, there is no motivation to combine Xidos and Rosen. As just mentioned, Rosen relates to electronic commerce communication, specifically, the making of

anonymous payments. However, Xidos teaches its own a payment and transaction system and does not contemplate anonymous payments. For example, Xidos states “game payments to a certain limit and transaction receipts are printed within the hotel using a printer accessible to hotel staff. Each payment and transaction receipt contains the card holder number to who the payment/receipt belongs. Upon check out or when requested, the hotel staff provides these to the player” (col. 7, ll. 14-19). There is no suggestion of anonymity in Xidos. In fact, the above paragraph suggests the contrary, *i.e.*, the identity of the user is of great importance to the payment process. Because Xidos is not concerned with anonymity, there is no motivation to combine Xidos with Rosen whose primary teaching is anonymous electronic commerce payments. Finally, because there is no motivation to combine, there is, consequently, no reasonable expectation of success.

Hindsight Construction

The lack of motivation to combine the above references, due to divergent and/or contrary teachings, seems to be a result of hindsight construction. For example, in the final Office Action mailed on December 2, 2003, states, “It would have been obvious at the time of the invention was made to a person having ordinary skill in the art in view of the teaching of Rosen and Thorner to ... select a demonstration mode so that the user has no substantial participation in effecting an outcome of a broadcast event.” The Applicant notes the independent claim before the present amendment stated, “wherein an outcome of the live-action broadcast event is not produced in response to a user.” It is not clear to how “the user ha[ving] no substantial participation in effecting an outcome of a broadcast

event” serves as a motivation (or reason) to combine for one of ordinary skill in the art, other than to recite the claim language of the present invention. Because there is no real motivation to combine these references and the proposed motivation to combine is simply a recitation of the claim, this appears to be hindsight construction, and thus, improper.

§103 Rejection Closing Comments

In view of the above, independent claim 29 is found to be patentable over Xidos, Rosen, and Thorner, whether considered individually or in combination, for several reasons. First, the applied references do not teach all of the limitations of the present invention. Additionally, there is no compelling motivation to combine these reference. Further, the references seem to be viewed in hindsight and arrived at only through the benefit of the Applicant’s disclosure. Finally, there is no reasonable expectation of success of combining the references, because there again has been no compelling motivation to even combine the applied references. Claim 40 is of similar scope as claim 29 and patentable for at least the same reasons. Further, claims 30-39 and 41-48, being dependent, are also patentable for at least the same reasons. Because claims 29-48 are patentable over Xidos, Rosen, and Thorner, withdrawal of the §103 rejection is respectfully requested.

III. Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 11345/025001).

Respectfully submitted,

Date: 3/2/04

Jonathan P. Osha, Reg. No. 33,986 48,885

Jonathan P. Osha, Reg. No. 33,986
Osha Novak & May L.L.P.
One Houston Center, Suite 2800
1221 McKinney Street
Houston, TX 77010
Telephone: (713) 228-8600
Facsimile: (713) 228-8778